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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/818,765 03/27/01 YAMAGUCHI

S 448563/0191

MM91/0607
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NEW YORK NY 10038

EXAMINER

NGUYEN, J

ART UNIT

PAPER NUMBER

2861

DATE MAILED:

06/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/818,765

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Judy Nguyen

Art Unit

2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/969,326.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: “the second opening” (lines 8, 9) lacks proper antecedent basis. “a separate opening” (line 6) should be changed to -a second opening- to correct the problem. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Schmidt et al (US 5,732,751).

Schmidt et al discloses all features of the claimed invention:

- removing the ink bag (24) from the ink jet recorder (the step is necessary, therefore, inherent, because the fill port 52 must be exposed so that the nozzle assembly 200 can be connect to it)

- positioning the ink bag (illustrated in Fig. 4)
- inserting an in needle (202) into a port (52) of the ink bag (24)
- discharging in from the ink bag through said port (this is done by evacuating the contents of the ink bag via vacuum source; see column 9, lines 31-45)
- charging the ink bag through said port with a specified quantity of ink (column 9, lines 54-56).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asai (US 4,928,126) in view of Schmidt et al.

Asai discloses the following elements of the claimed invention:

- an ink bag (10) having a sealed first opening (10z) and a second opening (10x).

However, Asai does not disclose the following:

- removing the ink bag from the ink jet recorder

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- positioning the ink bag
- inserting an in needle into the second opening of the ink bag different than the sealed first opening
- discharging in from the ink bag through the second opening
- charging the ink bag through the second opening with a specified quantity of ink.

Nevertheless, Schmidt et al discloses the following:

- removing an ink bag (24) from an ink jet recorder (the step is necessary, therefore, inherent, because the fill port 52 must be exposed so that the nozzle assembly 200 can be connect to it)
- positioning the ink bag (illustrated in Fig. 4)
- inserting an ink needle (202) into an opening (52)
- discharging ink from the ink bag through the opening (this is done by evacuating the contents of the ink bag via vacuum source; see column 9, lines 31-45)
- charging the ink bag through the opening with a specified quantity of ink (column 9, lines 54-56).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the aforementioned teaching of Schmidt et al in the teaching of Asai to refill the bag through the second opening having similar structure like the refilled opening of Schmidt so that the refill/second opening is different than the sealed first opening for the purpose of reusing the bag so that waste can be prevented.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy Nguyen whose telephone number is (703) 305-7062. The examiner can normally be reached on Monday - Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nancy Le can be reached on (703) 308-0750.

A handwritten signature in cursive script, appearing to read "Judy Nguyen".

June 5, 2001